



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,735	12/21/2000	G. Gregory Mooty	ASF98065 (021971-0168)	6901

7590 02/23/2005

RAYMOND M GALASSO
SIMON GALASSO & FRANTZ PLC
P.O. BOX 26503
AUSTIN, TX 78755-0503

EXAMINER

LE, HOA VAN

ART UNIT	PAPER NUMBER
----------	--------------

1752

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/746,735

Applicant(s)

MOOTY ET AL.

Examiner

Hoa V. Le

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 14-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 7-13 is/are objected to.
- 8) ☒ Claim(s) 14-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1752

This a Supplemental Office action.

I. It is informed by the Paper from the Paralegal Specialist at about 5:00 PM on 18 February 2005 that the Terminal Disclaimers over Patent Nos. 6,461,061 and 6,793,417 are not proper since the person signs the Terminal Disclaimer is not the attorney of record. Accordingly, the Office action is modified.

II. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 45-46, 48, 51-53 of U.S. Patent No. 6,461,061.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the embodiments in the applied claims encompass the embodiments in the instant claims with respect to a canning station comprising (1) a light source and (2) the station having an instrument (sensor) to measure light.

Art Unit: 1752

It is required to read the claimed embodiments in view of the disclosure in the specification. The light source is from an infrared laser and visible light on col.11: 25, 33-35, 45 and 58-61.

Accordingly, the instant claims are not patentably distinct from the applied claims in the patent. (The applied claims are patentably distinct from the instant claims only.)

III. Patent 6,793,417 is not applied because the claims are not related to point light source.

IV. Claims 1-2, 4 and 6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 24-26 of U.S. Patent No. 6,599,036.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the embodiments in the applied claims encompass the embodiments in the instant claims with respect to a canning station comprising (1) a light source and (2) the station having an instrument (sensor) to measure light.

It is required to read the claimed embodiments in view of the disclosure in the specification. The light source is from an infrared laser and visible light on col.14:4-25.

Accordingly, the instant claims are not patentably distinct from the applied claims in the patent. (The applied claims are patentably distinct from the instant claims only.)

V. Claims 1 and 6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6-7 of U.S. Patent No. 6,707,557.

Although the conflicting claims are not identical, they are not patentably distinct from each other

Art Unit: 1752

because the embodiments in the applied claims encompass the embodiments in the instant claims with respect to a canning station comprising (1) a light source and (2) the station having an instrument (sensor) to measure light.

It is required to read the claimed embodiments in view of the disclosure in the specification. The light source is from a point source of an infrared and near infrared spectrum on col.5:8-26.

Accordingly, the instant claims are not patentably distinct from the applied claims in the patent. (The applied claims are patentably distinct from the instant claims only.)

VI. Claims 1, 4 and 6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13, 21 and 24-27 as amended on 22 November 2004 of copending Application No. 09/748,788. Although the conflicting claims are not identical, they are not patentably distinct from each other because the embodiments in the applied claims encompass the embodiments in the instant claims with respect to a canning station comprising (1) a light source and (2) the station having an instrument (sensor) to measure light.

It is required to read the claimed embodiments in view of the disclosure in the specification. The light source is from a point source of an infrared and near infrared spectrum on page 6:24-28 of the instant application.

Accordingly, the instant claims are not patentably distinct from the applied claims in the patent. (The applied claims are patentably distinct from the instant claims only.)

Art Unit: 1752

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

VII. Applicant's arguments filed 27 December 2004 have been fully considered but they are not persuasive.

Applicants do not urge that the applied claims do not contain the instantly claimed embodiments (the embodiments in the applied claims encompass those in the instant claims) but urge that there are no obvious double patenting of the instant claims over the applied claims because the applied claims contain more embodiments than those in the instant claims. The instant claims have not been limited to "consisting of". No evidence on the record that the presence of an additional embodiments as urged would cause the claimed scanning station becoming inoperative. The language "comprising" in the instant claims is open to include an embodiment.

VIII. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Primo et al (6,181,809).

Art Unit: 1752

Primo et al disclose and teach a scanning station comprising a laser focusing on a photographic film and (a radiation (light) detector (sensor) from photographic film which has been advised that it is not patentably distinct from “operable...” since it is not a positive limitation but the ability only). Please see figure 1, column 3, lines 48-55 and column 4, lines 8-12.

Primo et al do not specify the embodiment of “for scanning...processing solution” in the preamble of the claims. It has been considered but has and is given a limited patentable value under the above applied statutory.

Since Primo et al disclose and teach the claimed embodiments, they are found to be anticipated by Primo et al.

IX. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Primo et al (6,181,809).

Primo et al disclose, teach and suggest a scanning station comprising a laser focusing on a photographic film and (a radiation (light) detector (sensor) from photographic film which has been advised that it is not patentably distinct from “operable...” since it is not a positive limitation but the ability only). Please see figure 1, column 3, lines 48-55 and column 4, lines 8-12.

Art Unit: 1752

Primo et al do not specify the embodiment of “for scanning...processing solution” in the preamble of the claims. It has been advised that the embodiment is not patentably distinct from Primo et al scanning station since the claimed scanning station (1) does not have or require the “film having a coating of processing solution” for the intended use process or (2) can be operated with a washing away processing solution photographic film as that in Primo et al.

Since Primo et al disclose, teach and suggest the scanning station containing the essentially claimed embodiments, they are found to be rendered prima facie obvious by Primo et al.

X. Primo et al (EP 0 452 570) in English language is cited to an essential equivalent to the above applied Primo et al (6,181,809).

XI. Claims 7-13 are objected to because they depend on the rejected claims. They would be allowable if they are rewritten in an independent form.

XII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Art Unit: 1752

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
22 February 2005

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le